

### Remarks

#### **Amendments to Claims:**

The claims 1, 3, 7, 12-16, and 19-21 have been amended as set forth above.

Specifically:

- Claim 1 has been amended to include the limitations of now-cancelled claim 2.
  - Claims 3 and 7 have been amended to be consistent with the amendment to claim 1.
  - Claims 12-16 have been amended to correct their dependency, to now recite that they are process claims and depend from claim 11.
  - Claim 17 has been amended to add a limitation supported by now-cancelled claim 18.
  - Claims 19-20 have been amended so that they are consistent with amended claim 17, and to correct dependency numbering.
  - Claim 21 has been amended to include a limitation found in now-cancelled claim 2.

Claims 2, 4, 8-10 and 18 are hereby cancelled, without prejudice.

New claims 22-24 have been added. Support for new claim 22 is found in original claim 3; support for new claim 23 is found in now-cancelled claim 4; support for new claim 24 is found in now-cancelled claim 8; and new claim 25 is supported by original claim 11.

### Rejection of Claims Under 35 U.S.C. § 112:

Claims 8-10, 12-16 and 18-20 have been rejected under 35 U.S.C. § 112 as being indefinite as being method claims depending from product claims.

1       With respect to claims 8-10 and 18, those claims have been cancelled, and  
2 therefore the rejection with respect to those claims is now moot.

3       With respect to claims 12-16, those claims were originally intended to  
4 depend from process claim 11. Through an oversight on the part of the Applicant's  
5 agent, both the preamble and the dependency numbering of those claims  
6 erroneously indicated that they were product claims depending from claim 10. As  
7 indicated in the section above, claims 12-16 have now been amended to recite that  
8 they are process claims, and depend from claim 11. As claim 11 has been allowed,  
9 the Applicant contends that claims 12-16 (which now depend from claim 11) are also  
10 allowable. The Applicant therefore requests that the rejection of claims 12-16 be  
11 removed and the claims allowed.

12      With respect to claims 19 and 20, the Applicant contends that those claims, as  
13 amended, do not recite method steps, but in fact further limit the apparatus of claim  
14 17. Specifically, claim 17 has been amended to further recite that the flexible flying  
15 disk comprises "an image formed of silicone ink on the body". Claim 19 has been  
16 amended to recite that the silicone ink is a heat cured silicone ink. That is, claim 19  
17 does not recite a method of applying the ink, but rather specifies the type of ink that  
18 is on the body of the disk. Further, claim 20 has been amended to recite that the  
19 image is "a silk screened visual image". That is, claim 20 does not recite a method  
20 of applying the ink, but merely specifies what the image is. Accordingly, the  
21 Applicant contends that claims 19 and 20 are not indefinite, and respectfully requests  
22 that the rejection of claims 19 and 20 under 35 U.S.C. § 112 be removed.

23

24 Rejection of Claims Under 35 U.S.C. § 103:

25      Claims 1, 5, 6, 8-10 and 12-21 have been rejected under 35 U.S.C. § 103 as  
being obvious over U.S. Patent No. 4,737,128 to Moormann et al. (hereinafter  
"Moormann") alone, or in view of U.S. Patent No. 5,199,717 Wimmer (hereinafter,  
"Wimmer").

1 As a starting point, MPEP 706.02(j) states:

2        "[t]o establish a *prima facie* case of obviousness, three basic  
3 criteria must be met. First, there must be some suggestion or  
4 motivation, either in the cited references themselves or in the  
knowledge generally available to one of ordinary skill in the art, to  
5 modify the reference or to combine the reference teachings.  
6 Second, there must be a reasonable expectation of success.  
7 Finally, **the prior art reference (or references when combined)**  
8 **must teach or suggest all the claim limitations.** The teaching  
9 or suggestion to make the claimed combination and the  
reasonable expectation of success must both be found in the prior  
10 art and not based on applicant's disclosure." (Emphasis added.)  
11

12 With respect to claims 1, 5, 6, and 8-10, claims 8-10 have been cancelled,  
13 and therefore the rejection of those claims as being obvious is now moot. With  
respect to claims 1, 5 and 6, claim 1 has been amended to include the limitations of  
14 claim 2. As claim 2 has been indicated as being allowable, the applicant contends  
15 that amended claim 1 should now be allowable. Since claims 5 and 6 depend from  
16 amended claim 1, those claims should also be allowable. The Applicant therefore  
17 requests that the rejection of claims 1, 5 and 6 as being obvious now be removed  
and the claims allowed.

18 With respect to claims 12-16, as indicated above, those claims have been  
19 amended to depend from claim 11. As claim 11 has been allowed, the Applicant  
20 contends that dependent claims 12-16 are also allowable. The Applicant therefore  
21 requests that the rejection of claims 12-16 as being obvious now be removed and  
the claims allowed.

22 With respect to claim 17, that claim has been amended to include an  
additional element (specifically, "an image formed of silicone ink on the body"). This  
element, originally found in now-cancelled claim 18, is essentially equivalent to the  
element recited in original claim 2. As claim 2 was indicated as being allowable, so  
too should claim 17, for the same reasons. Since claim 17 should now be allowed,  
claims 19 and 20 (which, as amended depend from claim 17) should also be

1 allowed. The Applicant therefore requests that the 35 USC § 103 rejection of claims  
2 17, 19 and 20 be removed and the claims allowed.

3 With respect to claim 21, that claim has been amended to include an  
4 additional element (specifically, "applying a visually discernable graphic on the  
5 flexible flying disk using silicone ink"). This element is essentially equivalent to the  
6 element recited in original claim 2. As claim 2 was indicated as being allowable, so  
7 too should claim 21, for the same reasons. Since claim 21 should now be allowed,  
8 new claims 22-24, which depend therefrom, should also be allowed. The Applicant  
9 therefore requests that the 35 USC § 103 rejection of claim 21 be removed, and that  
claims 21-24 allowed.

10 Fee for additional claim

11 The fee for one (1) additional independent claim is enclosed herewith.

12 Summary

13 The Applicant believes that this response constitutes a full and complete reply  
14 to the Office action, and therefore requests timely allowance of claims 1, 4-9, 12-16,  
15 and 18-40.

16 If the next Office action is anything other than a Notice of Allowance for claims  
17 1, 3, 5-7, and 11-25, the below-signed attorney respectfully requests that the  
18 Examiner call him before issuing the action.

19 Respectfully submitted,

20 Cory A. Siverson, Applicant

21 Date: June 23, 2004

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